

Claims Rejections

[4]-[5] **Claims Rejection under 35 U.S.C. § 102**

The Examiner has rejected Claims 1, 3, 9, and 10 under 35 U.S.C. § 102(b) as being anticipated by Szymanski (U.S. Patent 3,696,238 issued to Ronald Szymanski on 10/3/1972).

Anticipation Defined

MPEP § 2131 dictates the following definition of anticipation be applied to § 102 rejections:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) "The identical invention must be shown in as complete detail as is contained in the ... claim."
Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of

terminology is not required. *In re Bond*, 910

F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant asserts that the Examiner has not met the burden of proving anticipation in regards to the Applicant's claims as the cited reference does not disclose the claimed structure of Applicant's invention.

Standard for Prima Facie Case of Anticipation

To support an anticipation claim rejection under 35 U.S.C. § 102, the patent cited by the Examiner must include **all** of the claimed elements of the Applicant's invention. "[A]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." 220 USPQ at 313 (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)). It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Federal Circuit has indicated that "[i]n deciding the issue of anticipation, the trier of fact must

identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 220 USPQ 485.

The Applicant has included within the scope of the claimed invention a "Resealable Lip" that is both specifically defined in the Applicant's specification and drawings, and which is also absent from the disclosure of the Szymanski patent specification and drawings. As such, the Examiner's assertion of a § 102 rejection based on anticipation fails, as an essential element of the Applicant's invention is absent from the cited reference. A detailed discussion of this analysis follows.

Applicant has Defined and Included "Resealable Lip" in Claimed Invention

The Applicant is permitted to be his/her own lexicographer with respect to both the prior art and the present invention. See MPEP § 2111.01 ("Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage"). As long as the terminology is sufficiently clear for one of ordinary skill in the art to understand, the inventor is not restricted in the use of terminology to describe the disclosed invention.

Referring to the Applicant's specification and drawings, the Applicant has defined the term "resealable lip" by reference to

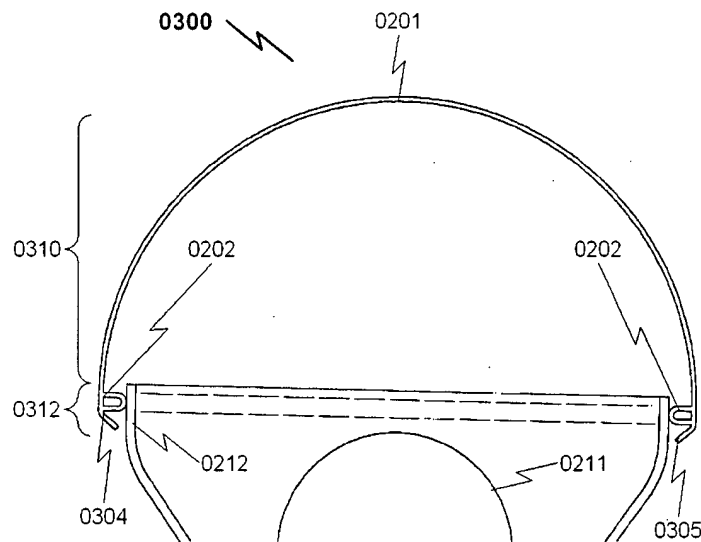
same in the specification on page 25:

A lamp fixture cover, having

...

a peripheral **resealable lip** (0312) conforming to the outer perimeter (0212) of a lamp fixture and attached to the generally hemispherical outer boundary of the lamp fixture body (0201);

This text makes specific reference to FIG. 3 item (0312) which is illustrated below:

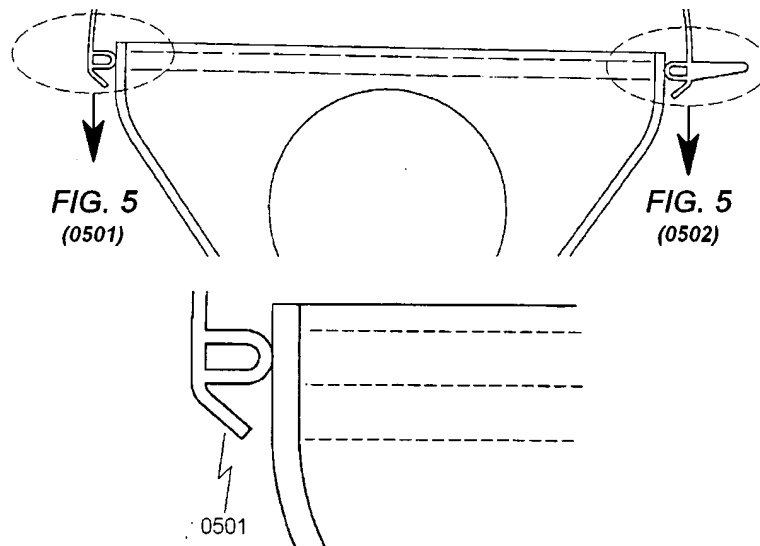


This **sealing lip** is also discussed on page 22:

FIG. 4 (0400) provides another side view of a presently preferred embodiment of the present invention. Here the detail includes illustrations of the **sealing lip** and

installation/removal tab that are further detailed in FIG. 5 as (0501) and (0502) respectively.

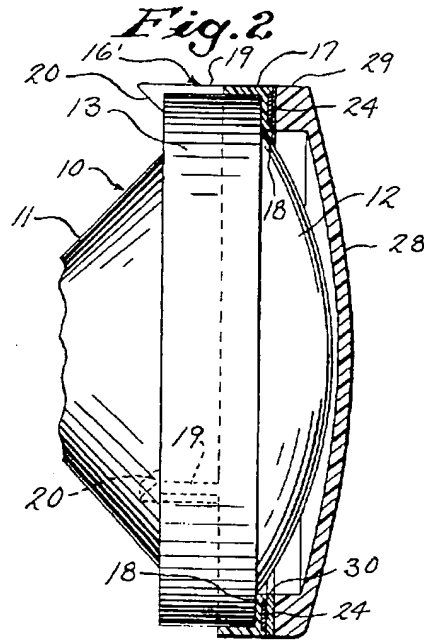
The graphic detail referenced in this text is reproduced below:



Thus, the Applicant has clearly defined the term "resealable lip" within the context of the specification and the claimed invention. However, the Examiner's reference to the Szymanski patent fails to specify how this structural element of the Applicant's claimed invention is disclosed within the Szymanski reference.

"Resealable Lip" Structure Absent from Szymanski Patent

The Examiner has stated that FIG. 2, item 17 in the Szymanski reference corresponds to the Applicant's claimed structure. This structure is illustrated below:



Note, however, that item 17 exhibits none of the structure illustrated in FIG. 3, 4, or 5 of the Applicant's invention as detailed in the figures from the Applicant's patent application reproduced above. In fact, the Szymanski patent specifically disclaims any structure similar to that taught by the Applicant when he states in Column 3, Lines 19-31:

"As is shown in said FIGS. 1 and 3, said attachment device 16 comprises a ring which is molded or otherwise formed of a flexible, tough durable plastic or comparable inexpensive flexible, material, and includes **a flat, horizontal body portion 17** and an inwardly directed vertical front flange 18. Said ring member is of a circumference to closely surround the aforementioned headlight

lens-retaining rim 13, the **flat body portion 17** of said ring being of a width substantially less than the lens-retaining rim, while said ring front flange 18 is designed to extend downwardly to a point immediately adjacent the outer peripheral edge of the headlight lens 12 (FIG. 1)."

Thus, the "peripheral resealable lip 17" cited by the Examiner as corresponding to Applicant's "resealable lip" is specifically detailed as being a "**a flat, horizontal body portion**" in the Szymanski reference as compared to the structure detailed in Applicant's figures and claims. Clearly, these structures do not in any way correspond, and there is no suggestion that any "resealable lip" structure similar to that detailed by the Applicant is present anywhere else in the Szymanski patent disclosure.

Claims 3,9,10 Rejection (Generally) – Claim Dependency

Claims 3,9,10 are dependent on Claim 1. Since the Applicants have successfully argued the allowability of Claim 1, dependent claims flowing from these allowable claims are patentable. As stated in MPEP § 608.01(n) (III):

"Examiners are reminded that a dependent claim is directed to a combination including

everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim."

Thus, the general arguments made for the allowability of Claim 1 are applicable to Claims 3,9,10 as they depend on an allowable independent base claim.

Conclusion

Applicant has rebutted the Examiner's prima facie case of § 102 anticipation based on the fact that the Applicant's invention teaches and claims a "resealable lip" that is absent from the cited Szymanski reference. As such, the Examiner's § 102 rejection is unfounded and claims 1-10 are allowable as originally drafted.

[6]-[9] Claims Rejection under 35 U.S.C. § 103

The Examiner has rejected Claims 11, 13, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Szymanski (U.S. Patent 3,696,238 issued to Ronald Szymanski on 10/3/1972) in view of Florence et. al. (U.S. Patent 4,323,954 issued to Noel S. Florence and Normann Lynn on 4/6/1982).

Standard for Prima Facie Case of Obviousness

Per MPEP § 706.02(j), to support a prima facie case for an obviousness rejection under 35 U.S.C. § 103, the Examiner must establish four basic criteria:

- First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- Second, there must be a reasonable expectation of success.
- Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
- The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

These criterion will be examined individually.

Suggestion/Motivation – Szymanski/Florence Does Not Disclose Structure

To support a claims rejection under § 103, the Szymanski/Florence references **must disclose or suggest the structure**

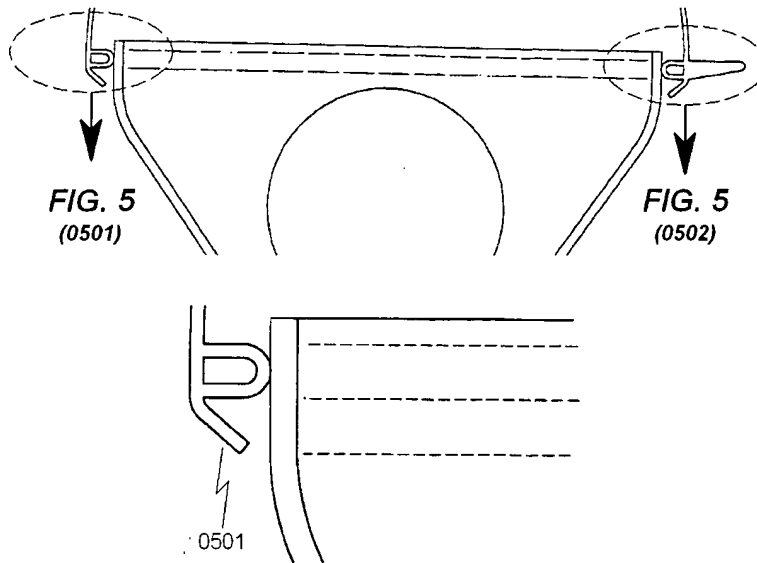
claimed by the Applicant. Claims rejections by the Examiner referencing the Szymanski/Florence patents are improper because the **flat, horizontal body portion 17** structure disclosed by the Szymanski patent does not disclose a resealable lip (**0312**) as detailed by Applicant's invention disclosure specification:

FIG. 4 (**0400**) provides another side view of a presently preferred embodiment of the present invention. Here the detail includes illustrations of the **sealing lip** and **installation/removal tab** that are further detailed in FIG. 5 as (**0501**) and (**0502**) respectively.

...

A lamp fixture cover, having ... a peripheral **resealable lip** (**0312**) conforming to the outer perimeter (**0212**) of a lamp fixture and attached to the generally hemispherical outer boundary of the lamp fixture body (**0201**)

The resealable lip structure has a specific form as detailed below and which is absent from the Szymanski/Florence references:



The Examiner has failed to disclose how this structure is taught or suggested by either the Szymanski patent or the Florence patent. Without some enabling disclosure in these references cited by the Examiner or some suggestion that the resealable lip structure taught by the Applicant can be substituted for the structures described by Szymanski/Florence, the Examiner's § 103 rejection fails the prima facie test for obviousness per MPEP § 706.02(j) as detailed above.

Teaching Away

Applicant's invention specifically references a "resealable lip" as detailed above which is absent in the Szymanski/Florence references. Szymanski actually teaches away from the concept of a "resealable lip" when he states

"The result is that said plastic ring member
can be mounted on the headlight without the

use of any tools, and **once mounted thereon it cannot be removed without considerable difficulty**, thereby discouraging the theft of said rings and eliminating the possibility of their coming off in use." Column 3, Lines 41-46.

Additionally, Szymanski teaches away from the use of a "resealable lip" to form the attachment means between the light cover and the light fixture when he states

"Said flexible plastic ring member **16** is provided with three (or any desired number) equally spaced, rearwardly extending **arm members 19** having **inturned hook elements 20** formed on their **outer ends**, and to install said ring member **16** on a headlight it is merely necessary to slip the same on and surrounding the headlight rim **13** and the flexibility of said arm members **19** causes the hook portions **20** thereof to securely engage with the rearward edge of said ring member." Column 3, Lines 32-41.

Thus, Szymanski teaches that attachment between the ring member to the light fixture is performed via the use of hook structures that "slip on and surround the headlight rim". Given that

Szymanski requires that there be three (or more) rearwardly extending arms, there is no provision in this design or structure to suggest any sealing capability between the lighting fixture cover and the lighting fixture itself. On the contrary, the "resealable lip" structure detailed by the Applicant's invention is neither taught by nor suggested by the Szymanski patent.

Given that the Szymanski/Florence references do not teach nor suggest all the claim limitations of Applicants' invention, the use of the Szymanski/Florence patents for the purposes of a § 103 rejection is improper.

Claim 21 Rejection

Applicants first state in response to Examiner's rejection that since the Base Claims (Claim 1/11) have been shown to be allowable, the dependent method claim which incorporates the novel structure of this system embodiment as an integral element of the method is therefore allowable. Rejection is therefore improper per MPEP § 608.01(n)(III).

Note that Claim 21 details the use of a "light fixture cover" having a "seal lip" as detailed in the Applicant's invention disclosure as follows:

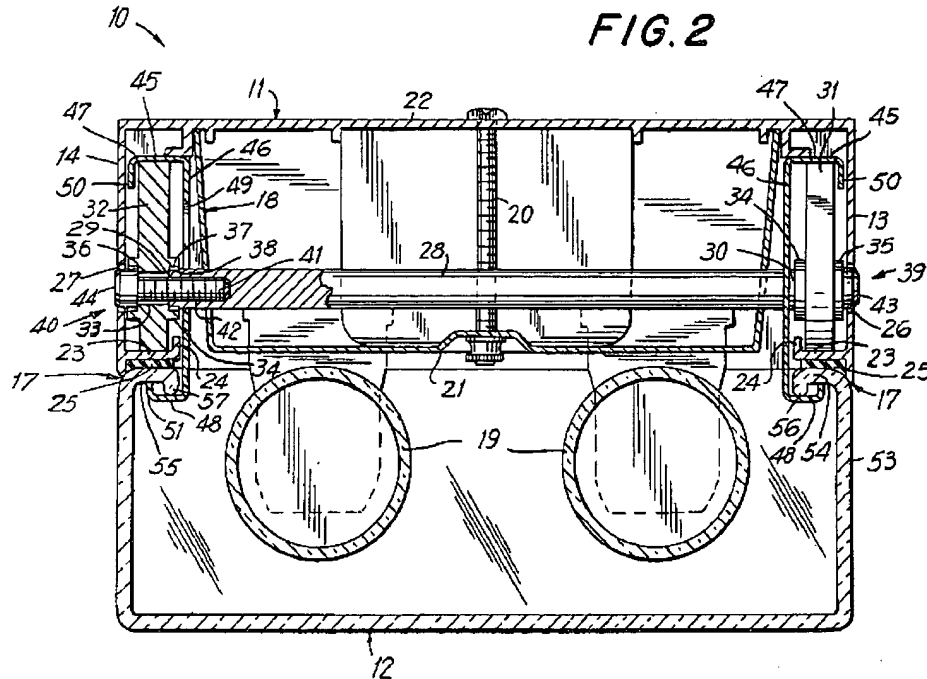
A light fixture covering method comprising:

... while holding said light fixture to be covered,
pressing the **seal of a light fixture cover** around
the perimeter of said light fixture to be covered,
engaging the **seal lip of said light fixture cover**
around the perimeter of said light fixture to be
covered.

Neither the Szymanski/Florence patents discloses or suggest the disclosure of a light fixture seal lip, and as such, essential elements of the method claim as detailed by the Applicant are missing from these references. Without some suggestion of using a seal lip as the method of attaching the light fixture cover to the light fixture itself, the Szymanski/Florence patents fail to provide sufficient support for a § 103 rejection of Claim 21.

Note, in contrast to the seal lip attaching means detailed in the Applicant's disclosure, Szymanski makes use of a magnetic means of attaching the light fixture cover to the light fixture. This actually teaches away from the method taught by the Applicant.

Additionally, the Florence patent requires the use of channels that are engaged with the light fixture cover via the use of a rotating shaft member as detailed in FIG. 2 of the Florence disclosure:



and detailed in the Florence patent in Column 4, Lines 14-24:

"In order to install a diffuser assembly **12**, the shaft **28** is rotated in an anti-clockwise direction to the position of FIG. 4 by the use of an Allen wrench or like torque applying instrument. In such position, the dwell portion is aligned with and engaged against the flange **47**, whereby the channels **45** are permitted to extend downwardly through the mouth portion **17** of the housing. In this position, the diffuser may be mounted or demounted as desired by engaging or disengaging the lip member **55** of the diffuser with the lower flanges **48** of the channels."

This structure is inconsistent with the "resealable lip" taught and claimed by the Applicant. The Applicant's invention specifically disclaims any use of mechanisms other than the resealable lip for attaching the lighting fixture cover to the lighting fixture. As such, the structure and disclosure of the Florence patent fail to suggest or motivate the claimed structure in the Applicant's invention.

Given these facts, reliance on the Szymanski/Florence patents as a basis for a § 103 rejection of Applicant's Claim 21 is improper.

Conclusion

Applicant has rebutted the Examiner's prima facie case of § 103 obviousness based on the fact that the Applicant's invention teaches and claims a "resealable lip" that is absent from the cited Szymanski/Florence references. As such, the Examiner's § 103 objection is unfounded and claims 11-21 are allowable as originally drafted.

Allowable Subject Matter

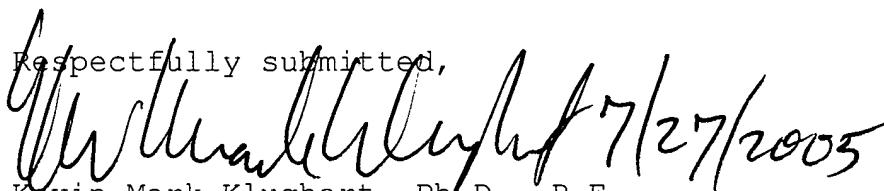
The Examiner's rejection/objection to Applicants' Claims has been overcome. All dependent Claims are now allowable as written, since they are dependent based on an allowable independent claims. See MPEP § 608.01(n)(III).

Request for Reconsideration

Applicants have placed the current patent application in a state believed to be suitable for allowance of all claims, and with all rejections/objections from the Examiner being fully addressed and rebutted.

Applicants respectfully request reconsideration of the Application based on the foregoing Amendment and Response. Applicants' attorney stands ready to assist the Examiner in any manner necessary to bring this patent application to allowance and encourages the Examiner to call if there are any questions or if any informal Examiner amendments can be made to bring this application to issuance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kevin Mark Klughart', followed by the date '7/27/2005'.

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